

**REMARKS****I. Summary of Office Action**

Claims 11, 13, 14, 16, 22, 23, 28, and 29 are pending in the application.

The Examiner has made the restriction requirement final.

Claims 11, 13, 14, 16, 22, 23, 28, and 29 have been rejected under 35 U.S.C. § 101.

Claims 11, 13, 14, 16, 22, 23, 28, and 29 have been rejected under 35 U.S.C. § 112, second paragraph.

Claims 11, 13, 14, 16, 22, 23, 28, and 29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 4,580,012 to Matthews et al. (hereinafter, "Matthews").

**II. Summary of Applicants' Response**

Claims 1-10, 12, 15, 17-21, 24-27 are withdrawn from consideration. Applicants have amended claims 11, 13, 14, 16, 22, 23, 28, and 29.

The Examiner's rejections of claims 11, 13, 14, 16, 22, 23, 28, and 29 is traversed.

Reconsideration of the application is respectfully requested.

**III. The Rejections Under 35 U.S.C. § 101**

The Examiner rejected claims 11, 13, 14, 16, 22, 23, 28, and 29 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In support of the rejections under 35 U.S.C. § 101, the Examiner stated that there is "no assurance that the received identifier is not a duplicate identifier," "the claimed invention will not be able to identify which transaction does the assent be associated with," and "there is no provision in the claimed invention as to who provided the transaction identifier to the user(s) to produce tangible results." (Office Action, page 3).

Applicants respectfully disagree but have amended the claims to advance prosecution. In particular, Applicants have amended claim 11, which describes a "method for recording consent to a transaction using a voice recording system and a transaction identifier corresponding to the transaction," to include, for example, "receiving the transaction identifier corresponding to the transaction at the voice recording system from the affirming party" wherein the transaction is "corresponding to the transaction identifier." Claim 28,

has been amended to include, for example, “receiving the transaction identifier corresponding to the transaction,” wherein the transaction is “corresponding to the transaction identifier.”

Applicants have amended claim 22, which describes a “method for recording a solemn declaration,” to include, for example, “receiving a declaration identifier at a recording system from an affirming party,” wherein the solemn declaration is “corresponding to the declaration identifier.”

Accordingly, Applicants respectfully assert that claims 11 and 28 produce the useful, concrete, and tangible result of, for example, “recording a voice message received from the affirming party, the voice message indicating that the affirming party assents to the transaction corresponding to the transaction identifier.” Applicants also respectfully assert that claim 22 produces the useful, concrete, and tangible result of, for example, “receiving a voice message at the recording system from the affirming party, the voice message including a statement of the solemn declaration corresponding to the declaration identifier” and “recording and storing the voice message at the recording system.”

Applicants respectfully assert that currently amended claims 11, 13, 14, 16, 22, 23, 28, and 29 are directed to statutory subject matter. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 101.

#### **IV. The Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 11, 13, 14, 16, 22, 23, 28, and 29 under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps. In support of his rejections, the Examiner stated, for example, that, “[r]eceiving of a transaction identifier by a user to produce tangible results” was an omitted essential step and that “applicant has not positively claimed how the received transaction identifier is used in the claimed invention” (Office Action, page 4). Applicants note that claim 11, for example, recites “receiving the transaction identifier corresponding to the transaction at the voice recording system from the affirming party” where the transaction is “corresponding to the transaction identifier.” Therefore, Applicants assert the transaction identifier is being used, for example, to identify the transaction.

The Examiner also stated, for example, that “ensuring all the parties involved in a

transaction use the same transaction identifier” is an omitted essential step. Applicants note claim 11 recites, “receiving the transaction identifier corresponding to the transaction at the voice recording system from the affirming party” and that the voice message indicates that the affirming party assents to “the transaction corresponding to the transaction identifier.” Applicants assert that it is clear that the parties involved in the transaction are using the transaction identifier.

In rejecting independent claim 22, the Examiner also stated that the Applicants have “not positively claimed how the received declaration identifier is used in the claim invention” (Office Action, page 5). Applicants note that amended claim 22 recites, for example, that the declaration identifier is “corresponding to the declaration” and that the “declaration is corresponding to the declaration identifier.” Accordingly, Applicants assert that it is clear that the declaration identifier is being used in currently amended claim 22 to identify the declaration.

Applicants respectfully assert that claims 11, 13, 14, 16, 22, 23, 28, and 29 are definite and do not omit essential steps. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 112, second paragraph.

**V. The Rejections of Independent Claims 11, 22, and 28 Under 35 U.S.C. § 103**

The Examiner rejected claims 11, 13, 14, 16, 22, 23, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Matthews. In support of his rejection of claim 11, the Examiner asserted that “receiving a transaction identifier at the voice recording system” of claim 11 is shown or suggested by “identification of the recipient of the audio recording” of Matthews (Office Action, page 6, emphasis added). The Examiner also stated that “Mathews does not explicitly teach the voice message indicating that the affirming party assents to the transaction” and instead of providing prior art that the Examiner believed to show or suggest this element, the Examiner stated that the “applicant is claiming content of the audio recording as their claimed invention” (Office Action, page 6). Finally, the Examiner stated that “it would have been obvious to one of ordinary skill in the art at the time the invention was made that is capable for recording audio messages with the content indicating that the affirming party assents to the transaction” (Office Action, page 6).

Applicants respectfully disagree and traverse this rejection below.

Matthews describes a voice message system that can, for example, receive, store, and

forward messages from a user's telephone. In Matthews, a telephone number identifies a recipient of an audio recording.

In sharp contrast, independent claim 11, for example, recites a method for recording consent to a transaction where a transaction identifier corresponds to a transaction. Matthews does not show or suggest anything related to, for example, a voice message indicating that an affirming party assents to a transaction. The Examiner's assertion that "receiving a transaction identifier at the voice recording system" of claim 11 is shown or suggested by the "identification of the recipient of the audio recording" of Matthews, illustrates, for example, that instead of identifying a transaction, Matthews identifies a recipient. Nothing in Matthews shows or suggests a "transaction identifier corresponding to a transaction" as recited by claims 11 and 28. Furthermore, nothing in Matthews shows or suggests receiving the transaction identifier "from [an] affirming party" as recite by claims 11 and 28.

Moreover, Applicants agree with the Examiner that "Matthews does not explicitly teach the voice message indicating that the affirming party assents to the transaction." However, Applicants respectfully disagree that "applicant is claiming content of the audio recording as their claimed invention" (Office Action, page 6). As a claim is defined by the combination of its elements, Applicants respectfully point out that much more is claimed than recording a message. For example, claims 11 and 28 recite, for example, "recording a voice message received from the affirming party, the voice message indicating that the affirming party assents to the transaction corresponding to the transaction identifier." This is not shown or suggested by Matthews.

Because the Examiner has not provided any indication of what in Matthews, or in any other prior art reference, he believes shows or suggests anything relating to assenting to a transaction, it cannot be obvious from the prior art of record to arrive at a system "capable for recording audio messages with content indicating the affirming party assents to the transaction" as stated by the Examiner on page 6 of the Office Action. Furthermore, as discussed, Applicants are not merely claiming "recording audio messages with content indicating the affirming party assents to the transaction," because, for example, claim 11 requires "receiving [a] transaction identifier corresponding to the transaction."

Additionally, even assuming that the Examiner had provided prior art showing or suggesting that an "affirming party assents to the transaction," which he has not, the Examiner

still has not provided any indication of what in the prior art shows or suggests combining, for example, “recording a voice message received from the affirming party” and “the voice message indicating that the affirming party assents to the transaction corresponding to the transaction identifier” as recited in claim 11 and 28.

Similar arguments apply to claim 22, which recites a “method for recording a solemn declaration.” For example, the Examiner has not provided prior art that shows or suggests, a “declaration identifier corresponding to the declaration” or a “voice message including a statement of the solemn declaration corresponding to the declaration identifier” as recited by claim 22.

Accordingly, independent claims 11, 22 and 28 are patentably distinct from Matthews. Applicants respectfully request that the Examiner withdraw the § 103 rejections to claims 11, 22, and 28.

#### **VI. The Rejection of Dependent Claims 13, 14, 16, 23, and 29 Under 35 U.S.C. § 103**

Applicants submit that claims 13, 14, 16, 23, and 29, each of which depends from one of claims 11, 22, and 28, are allowable for at least the same reasons that independent claims 11, 22, and 28 are allowable. Therefore, Applicants respectfully request that the Examiner withdraw the rejections to claims 13, 14, 16, 23, and 29.

#### **VII. The Inclusion Under 37 CFR § 1.111(c)**

The Examiner cited U.S. Patent No. 5,159,180 to Feiler (hereinafter, “Feiler”) and reminded the Applicants of their duties under 37 CFR § 1.111 (Office Action, page 9). Applicants have reviewed Feiler and considered the reference fully, along with the cited prior art, when responding to the Office Action. However, Feiler, which describes barcode technology in a litigation support system, appears to be totally unrelated to Applicants’ claimed invention. It does not show or suggest any of the elements of claims 11, 13, 14, 16, 22, 23, 28, or 29.

**CONCLUSION**

Applicants respectfully submit that, as described above, the cited reference does not show or suggest the combination of features recited in the claims. Furthermore, Applicants do not concede that the cited reference shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited reference, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants have provided examples of why the claims are distinguishable over the cited prior art.

Any amendments made to the claims in the present Reply are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather, these amendments are merely Applicants' attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

For at least the reasons set forth above, Applicants respectfully submit that this application is in condition for allowance. Reconsideration and prompt allowance of the application are respectfully requested.

Date of Deposit: January 2, 2007

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment, to Deposit Account No. 08-0219

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 08-0219.

Respectfully submitted,

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